IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Bates et al.	§	Filed: December 27, 2000
	§	
	§	Group Art Unit: 2421
Serial No.: 09/749,106	§	
	§	Examiner: Ngoc K. Vu
Confirmation No.: 6268	§	

For: Method and System for Pricing a Programming Event Viewed by Subscriber Group

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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June 1, 2009 /Joseph Jong/
Date Joseph Jong

Dear Sir:

REPLY BRIEF

Applicants submit this Reply Brief to the Board of Patent Appeals in response to the Examiner's answer dated March 30, 2009.

While Applicants maintain each of the arguments submitted in Applicants' previously submitted Appeal Brief, Aplicants make the following further arguments in light of the Examiner's Answer.

Applicants' remarks/arguments begin on page 2 of this paper.

ARGUMENTS

1. Rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Bonomi* in view of *Sartain* and in further view of *Pallakoff*.

The Applicable Law

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of Graham v. John Deere Co. 383 U.S. 1 (1966). The factual inquiries are as follows:

(A) determining the scope and content of the prior art;

(B) ascertaining the differences between the claimed invention and the prior art;

(C) resolving the level of ordinary skill in the art; and

(D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Respectfully, Applicants submit that the Examiner has not properly characterized the teachings of the references and/or the claims at issue. Accordingly, a prima facie case of obviousness has not been established.

The References

Bonomi is directed to a method and system for delivering media services and application over networks. *See Bonomi,* Title.

Sartain discloses an interactive video system which provides for the distribution of digital video programs to a predetermined group of subscribers. Video programs are broadcast to the group of subscribers, each of whom then each have the option of selecting one of the digital via programs for broadcast to the group. *See Sartain,* Abstract.

Pallakoff is directed to a method and system for marketing products and services utilizing the internet. *See Pallakoff*, Col. 1, Lines 11-13.

Applicants' Response to the Examiner's Answer

In its Appeal Brief Applicants made the following argument:

> "…the Examiner states that subscribers may be defined as a subscriber group according to their common location on the same block of a street or by the language that they speak, as disclosed by the *Sartain*, in order to help an operator at the provider to "easily update the list of subscribers and/or distribute programming to subscribers in an effective manner". Final Office Action, page 3. However, the Examiner gives no reason why modifying *Bonomi* to include subscriber groups would facilitate updating the list of subscribers and/or allow for the effective distribution of programming. In fact, Applicants respectfully submit that these objectives are already achieved by the *Bonomi* and are in no way further facilitated by the proposed modification. For example, updating the record for "Customer X" is in no way facilitated by defining a subscriber group that includes "Customer X". In either case, the provider must still select and edit the record corresponding to Customer X."

Applicants' Appeal Brief, page 11.

In the Examiner's Answer, the Examiner responds by conceding "that the method of updating a list of subscribers in *Bonomi* is not clearly improved by the subscriber grouping of *Sartain*." Examiner's Answer, page 7, lines 3-5. The Examiner now argues, however, that *Bonomi* does not disclose the benefit of distributing programming to subscribers in an effective manner as can be seen with reference to Figure 1B of *Bonomi*. See, Examiner's Answer, page 7, 5-7. Specifically, the Examiner maintains that the video delivery Center 152 of the reference is inefficient because it must contain all the video content desired by the client machines 162 and 164 even if certain client machines will never request certain contents. See, Examiner's Answer, page 7, 7-10. The Examiner then proposes that the alternative arrangement offered by *Sartain* is superior in which the client machines 130-140 are divided into groups, each group being serviced by an earth headend 110-114. First, Applicants point out that *Bonomi* teaches away the basic concept of grouping subscribers as described in Applicants' Appeal

Brief, and elaborated on below. For this reason alone, the proposed modification is untenable. Second, *Bonomi* specifically teaches the provision of *on-demand broadcasts* to the clients. By definition, such broadcasts are not scheduled but are instead provided immediately in response to a real-time request. As such, the media delivery center 152 ***must*** contain video content that may never be requested by certain clients. Again, this is precisely what makes a reference is incompatible: *Bonomi* caters to individuals, *Sartain* caters to groups. Accordingly, the rationale proposed by the Examiner for combining the references is undermined by the teachings of *Bonomi* itself.

In its Appeal Brief Applicants also argued that *Bonomi* actually teaches away from the modifications suggested by the Examiner. Applicants pointed out that one of the objectives of the *Bonomi* is to achieve a higher level of granularity in order to customize the service of individual users:

> Yet another aspect of the invention is that services provided by the media delivery system can be restricted differently for different users of a common subscriber account. *Bonomi*, paragraph 2, lines 49-51.

Therefore, any content delivery model that determines services provided to subscribers by treating the subscribers as a group, rather than individuals, is directly contrary to one of the objectives of the *Bonomi*. Therefore, the *Bonomi* teaches away from the modifications suggested by the Examiner.

The Examiner responds by arguing that:

> The addition of the teachings of the second reference, however, furthers this objective by customizing the services provided to the users based on their needs.

Examiner's Answer, page 7, 18-20.

Respectfully, the statement is entirely conclusory. The Examiner provides no explanation as to which services are customized by *Sartain*. In fact, as has been pointed out repeatedly by Applicants *Bonomi* caters to individuals, *Sartain* caters to groups. Thus, it is entirely unclear how the Examiner proposes that the group-based model of *Sartain* will provide customization of services to *individuals*, per *Bonomi*. Quite to the contrary of the Examiner's assertion, grouping the subscribers as taught by

Sartain is inconsistent with the teaching of *Bonomi*, which seeks to achieve a higher level of granularity in order to customize the service of individual users of common subscriber account. Further, even assuming *arguendo* that *Sartain* does provide customized services, the specific limitation at issue here is one dealing with subscriber groups. Thus, the burden is on the Examiner to make a *prima facie* case of obviousness with respect *to this particular limitation* (as well as all other limitations of the claim). The fact that some aspects of the references may be combinable does not support the conclusion that all aspects of the references are combinable to render a particular claim obvious. In this case, the Examiner proposes a modification where the relevant teachings of the references are at odds with one another. Accordingly, the references cannot be combined/modified in the manner proposed by the Examiner to teach "receiving, via a network connection, a purchase order for a program from a subscriber belonging to a subscriber group defined by two or more subscribers, wherein each subscriber belonging to the subscriber group maintains an independent account with the programming provider whereby the subscriber pays the programming provider in order to receive paid for programming, wherein each subscriber belonging to the subscriber group may elect to purchase or not purchase the program, and wherein the programming provider maintains a plurality of subscriber groups, wherein each group includes a subset of subscribers and wherein members of each subscriber group are determined prior to an offer to purchase the program".

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

CONCLUSION

The Examiner errs in finding that claim 5 is unpatentable over *Bonomi* in view of *Sartain* and in further view of *Pallakoff* under 35 U.S.C. § 103(a).

Withdrawal of the rejection and allowance of claim is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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